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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/742,679	12/20/00	LUCIANO R	732.462 SDG.

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EXAMINER	
CHERUBIN, Y	
ART UNIT	**PAPER NUMBER**
3713	4

DATE MAILED: 09/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application N . 09/742,679	Applicant(s) LUCIANO ET AL.
	Examiner Yveste G. Cherubin	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DET AILED ACTION

1. This office action is in response to the communication of Application received on December 20, 2000 in which claims 1-91 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claims 17, 31-33, 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 17, the term "online merchant" is ambiguous. What is an "online merchant"? The claimed limitation "online merchant" is being read as "prize distributor from a remote site".

b) In claim 23, 34, the term "activity unrelated to the play of gaming device" is ambiguous. Clarification is required.

c) Claims 31-33, 38-40 recite the limitation "prize center". There is insufficient antecedent basis for this limitation in the claims. Appropriate correction is required.

Claim Objections

3. a) The numbering of claims 72 on page 48 is improper. Misnumbered claim 52 on page 48 has been renumbered 72.

b) The dependency of claim 26 is improper. Appropriate correction is required.

c) Claims 27, 41 89 are objected to because of the following informalities:

- On page 38, line 9, the word "*associated*" needs to be changed to "*associate*".

- On page 41, line 20, the word *"with"* between –credits- and –said- needs to changed to "*to*".
- On page 51, line 22, the word "*a*" between –via- and -information- needs to be changed to "*an*".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

Claims 1-11, 14-22, 24-32, 41-45, 47-48, 50-66, 68-79, 81-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly (US Patent No. 6,015,344).

As per claims 1, 3, 26, 63, 66, 70, 88, 90-91 Kelly discloses a system and method of use of a prize redemption system. Kelly's system allows players to play a game on a game apparatus in exchange for monetary input and wherein prize credits are credited to the players based on the game. Kelly discloses a prize table or station capable of being displayed on a separate operator terminal, computer, server, or game unit that may be linked to game unit (10), 13:7-9, 35:50-56. Kelly further discloses a network gaming system wherein upon winning, players get awarded prizes from a prize supplier. As per claim 2, Kelly discloses that the prize supplier and the game supplier can be the same entity, 58:67, 59:1-2. Regarding claim 4, Kelly discloses using encrypted

identification information included on tickets to allow the prize supplier to validate the printed tickets, 59:48-65. As per claim 5, in 7:55-67, Kelly discloses that his validation unit could be included in the gaming machine and further he states that his gaming machine could also be configured to be a prize station, therefore it is apparent that his validation device is operatively coupled for communication with the gaming device and the prize station device. Regarding claim 6, Kelly discloses a vending machine to house the prizes, 1:36-51. As per claim 7, Kelly discloses a prize display area such as a prize booth or prize vending machine wherein prizes are visible to players, 1:36-51, 5:4-6. As per claim 8, Kelly discloses that players can turn in prize tickets to an attendant, bartender, waiter, etc. Regarding claim 9, Kelly discloses that prizes can be redeemed without an attendant such as through a vending machine, wherein the vending machine accepts prize tickets as currency in exchange for one or more prizes, 9:49-55. As per claim 10, Kelly discloses using a prize station comprising a vault housing, having a door secured by a latch in the form of a vending machine, 1:55-57. Regarding claim 11, Kelly discloses that players can be sent prizes via mail or delivery services, 11:15-19. As per claim 14, Kelly discloses that his prize supplier or station can as well be a separate computer terminal, 8:9-16. As per claim 15-17, Kelly discloses that for networked game processes and/or tournament, a local area network could be implemented to link the game units at one site and where a server would be a central computer or game apparatus that stores central data and coordinates prizes, 17:58-67. Alternatively, a wide are network or an existing global network such as the Internet and/or the World Wide Web could also be implemented to link different gaming

sites which themselves are linked to a central server which can coordinate prize information, 18:38-65. As for redeeming prizes via an online merchant, Kelly discloses that players may be remotely awarded prizes from prize distributor over a network. As per claims 18-20, 51, 71, 81-84, 89, Kelly discloses awarding credits to players using tickets or coupons, 3:60-65, or vouchers, computer storage, 5:1-6, 11:63-67, 12:1-21, wherein all of the above can be considered as prize bearing instrument configured to associate award credits with players. As per claims 21-22, 82-84, Kelly discloses that other types of objects such as paper or cardboard tickets, special metal, plastic, or cardboard coins or tokens, smart cards, etc., can be used as prize tickets, 10:62-67, 11:1-4, 63-67, 12:1-21. Regarding claim 24, Kelly discloses allowing players to play for special or progressive goals in order to win additional tickets, thereby awarding second award credit in order to promote players to play the gaming device, 10:30-34, 13:16-36. As per claim 25, in reference to Fig. 6c, Kelly discloses a plurality of prizes as shown. As per claim 27, Kelly discloses awarding tickets associated with additional award credits, 10:32-34. As per claims 28, 30, 41, 43-44, 47, 72, 74, 86, they recite issuing additional award credits upon winning events already discussed in claim 27 above, therefore refer to claim 27 for rejection; in addition, Kelly discloses a gaming device configured to determine the number of previous award credits associated with players, 13:49-67, 15:1-14, and store award credits upon user's termination of play of gaming device is well known. As per claims 29, 42, 73, in 12:22-39, Kelly discloses issuing universal tickets indicating the value of all the award credits accumulated by the players. This feature is analogous to the claimed feature of claim 29 since they both allow tickets

or prize bearing instrument to show the latest status of players' award credits. As per claim 31, Kelly discloses that players can take a card or other medium which stores electronic data and insert it into a suitable card reader connected to a prize selection apparatus or prize supplier wherein the prize supplier can be a game unit or a separate "prize center", 13:4-8. In addition, Kelly teaches the inherency of determining the number of redeemable award credits. As for claims 32, 45, 48 in reference to Fig 6b, Kelly's system offers a prize selection menu allowing players to select desired awards upon winning, 3:31-34, 51-56. Regarding claim 50, Kelly discloses smart card as award credit tickets. As per claim 52, Kelly discloses bonus award being added to players' game score and allowing players to win a greater number of prize credits, 13:25-30. As per claim 53, Kelly discloses the inherency of awarding any type of award credits. As per claims 54-55, since Kelly said that his gaming device could also be configured as a prize station, it is apparent that he could apply the teaching of the gaming device of claim 52, to award bonus to players when players are associated with predetermined collection of prizes. As per claim 56, Kelly discloses a monitoring device, 13:48-53. Regarding claims 57-60, Kelly discloses gaming device comprising slot machine, a video poker machine, a video lottery device, a casino table game, 1:27-40, 8:39-46. As per claims 61, 75, Kelly discloses a gaming system wherein winning gaming result arises from a random event in the game, 37:31-33. Regarding claims 62, 76, having the winning game result arising from a predetermined game result allocated from a finite pool of game play results is old and well known in the art. As per claims 64-65, Kelly discloses that players may purchase associated prizes, 36:27-29. As per

claims 68-69, Kelly discloses a hierarchy of prize menu system, wherein player can select prizes by categories in exchange for award credits, 30:8-10. Regarding claims 77-79, 87, gaming devices configured with primary and secondary games are well known, and having winning result arising from the primary game or the secondary game is also old and well known in the art. As per claim 85, determining players previously stored award credits upon player's reinitiation of game play of the gaming device is a known feature in the gaming environment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

Claims 12-13, 23, 33-40, 46, 49, 67, 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (US Patent No. 6,015,344).

As per claims 12-13, Kelly discloses that the tournament prize can be in a form of currency, such as prize credits, vouchers, or cash that are exchangeable for other prizes, therefore not having award credit being redeemable for cash by said prize station or the gaming device would have been a matter of design choice. In reference to advertisement, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prevent the disbursement of cash in exchange for award credits in order to enhance advertising effects on players. As per claims 23, 33-34, 40,

46, 49 Kelly discloses that his system is configured to determine the number of remaining award credits from said redeemable award credits after said redeemed prize is awarded to player, however he does not explicitly teach that his prize center is configured to issue other prize bearing instrument configured to associate remaining award credits with player. One of ordinary skill in the art would have been motivated to include such feature into the Kelly type system in order not to pressure the players to claim all the award credits at one time and allow them to accumulate award credits for more valuable prize awards. As per claims 35, 38, Kelly further discloses his system allowing players to receive more than one prize tickets to redeem award prizes. As per claim 36 refer to claim 28 above for rejection. Regarding claim 37, refer to claim 29 above for rejection. As per claim 38, refer to claim 31 above for rejection. Regarding claim 39, refer to claim 32 above for rejection. As per claim 67, configuring the prize station to award prize to players only when player has earned award credit on each of a predetermined subset of a plurality of gaming devices would have been a matter of design choice. One of ordinary skill in the art would have been motivated to provide such a system in order to encourage players to try all different machines offered at that facility. Regarding claim 80, issuing award credit upon user's termination of play of the gaming device would be obvious. One of ordinary skill in the art would have been motivated to set it up as such in to order provide one ticket upon accumulated winnings and therefore avoid providing a lot of individual tickets.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US Patent No. 6,007,426to Kelly et al. which teaches skill based prize games for wide area networks.

b. US Patent No. 6,009,412 to Storey which teaches fully integrated on-line interactive frequency and award redemption program.

c. US Patent No. 5,983,196 to Wendkos which teaches interactive computerized methods and apparatus for conducting an incentive awards program.

d. US Patent No. 6,061,660 to Eggleston which teaches system and method for incentive programs and award fulfillment.

7. It comes to the Examiner's attention that the Applicants have numerous applications in front of the office. At this time, a few of these applications are unavailable to the Examiner, therefore they are not being examined for double patenting. However, a double patenting examination will have to be made before allowing any of these provisional applications. The Examiner is requesting for the Applicants to draw a line of demarcation for each of these applications in order to assist the Office in the examination process.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

September 7, 2001

ygc ygc

JESSICA J. HARRISON
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.